<u>REMARKS</u>

Claims 3, 10 and 17 are pending. Claims 1, 8 and 15 are rejected under 35 U.S.C. §102(e). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

Applicants amended claims 3, 10 and 17 to include additional language to clarify the claimed subject matter. Support for the additional language may be found at least in part on page 7, line 31 – page 8, line 5 of Applicants' Specification. These amendments were not made to overcome prior art but to clarify the claimed subject matter. Hence, no prosecution history estoppel arises from the amendments to claims 3, 10 and 17. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 3, 10 and 17 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

I.   <u>REJECTIONS UNDER 35 U.S.C. §102(e):</u>

The Examiner has rejected claims 3, 10 and 17 as being anticipated by Xue et al. (U.S. Patent No. 6,782,414) (hereinafter "Xue"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation <u>must</u> be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants respectfully assert that Xue does not disclose "if a failed delivery e-mail message is received, setting an indicator in an entry in one of an address book, an address database, and an address cache associated with an address of an addressee corresponding to the failed delivery message" as recited in claim 3 and similarly in claims 10 and 17. The Examiner cites column 12, lines 42-60 of Xue as disclosing

the above-cited claim limitation. Office Action (7/9/2008), page 3. Applicants respectfully traverse.

Xue instead discloses that message 822 has failure indicator 828, message 824 has pending indicator 830, and message 826 has success indicator 832. Column 12, lines 43-45. Xue additionally discloses that the type of visual information provided by an overall delivery status indicator may vary depending upon system implementation, e.g., a special icon may be associated with each type of protocol-neutral status supported by the system. Column 12, lines 45-49. Furthermore, Xue discloses that text labels may also be used with each message. Column 12, line 49. Additionally, Xue discloses the use of a stop icon that is associated with a message that has failed to be delivered to each intended recipient. Column 12, lines 53-55.

Hence, Xue discloses a failure indicator used to indicate the failed delivery of a message. Xue additionally discloses a stop icon that is associated with a message that has failed to be delivered to each intended recipient.

However, there is no language in the cited passage that discloses <u>setting an indicator in an entry in one of an address book, an address database, and an address cache</u>. Thus, Xue does not disclose all of the limitations of claims 3, 10 and 17, and thus Xue does not anticipate claims 3, 10 and 17. M.P.E.P. §2131.

Applicants further assert that Xue does not disclose "wherein, if said indicator is set, said indicator is operable for clearing in response to said address becoming accessible" as recited in claim 3 and similarly in claims 10 and 17. The Examiner cites column 8, lines 30-37 and column 12, lines 42-60 of Xue as disclosing the above-cited claim limitation. Office Action (7/9/2008), pages 3-4. Further, the Examiner particularly focuses on the teaching of a "stop icon" as disclosing the setting of the indicator. *Id.* at page 3. Applicants respectfully traverse.

Xue instead discloses that at step 302, the incoming mailbox of the sender is updated in some manner to reflect that an outgoing message was successfully transmitted. Column 8, lines 30-32. Xue further discloses that at step 304, if the delivery status notification ("DSN") was received in the time period that was expected for its associated outgoing mail message, the recipient identified in a DSN is

reconciled with the recipient lists in the outgoing mail message. Column 8, lines 33-37. Xue additionally discloses that the statuses "Success", "Delay", and "Failure" are generally derived from similar, protocol-specific, status codes that are returned in a DSN. Column 9, lines 3-5. Xue further discloses that although the "Expired" status value connotes additional information about the reason why a message has failed to be delivered, the "Expired" status value can be merged with the "Failure" status code. Column 9, lines 20-23. Furthermore, Xue discloses that message 822 has failure indicator 828, message 824 has pending indicator 830, and message 826 has success indicator 832. Column 12, lines 43-45. Xue additionally discloses that a stop icon is associated with a message that has failed to be delivered to each intended recipient. Column 12, lines 53-55.

Hence, Xue discloses that the statuses "Success", "Delay", and "Failure" are generally derived from similar, protocol-specific, status codes that are returned in a DSN. Further, Xue discloses that although the "Expired" status value connotes additional information about the reason why a message has failed to be delivered, the "Expired" status value can be merged with the "Failure" status code. Xue further discloses using a stop icon to indicate that a message has failed to be delivered. Further, Xue discloses a failure indicator to indicate that a message has failed to be delivered. Furthermore, Xue discloses that the incoming mailbox of the sender is updated in some manner to reflect that an outgoing message was successfully transmitted.

While Xue discloses updating the incoming mailbox of the sender to reflect that an outgoing message was successfully transmitted, there is no language in Xue that discloses that once a failure status code is set that it can be cleared. That is, there is no language in Xue that once the intended recipient is marked with a failed status, that the failed status can change.

Hence, there is no language in Xue that discloses that the stop icon or failure indicator (Examiner asserts that the stop icon or failure indicator of Xue discloses the claimed indictor) is operable for clearing in response to the address becoming accessible. That is, there is no language in Xue that discloses that the indicator,

associated with an address of an addressee corresponding to the failed delivery message, is operable for clearing in response to the address becoming accessible.

Thus, Xue does not disclose all of the limitations of claims 3, 10 and 17, and thus Xue does not anticipate claims 3, 10 and 17. M.P.E.P. §2131.

Applicants further assert that Xue does not disclose "clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message" as recited in claim 3 and similarly in claims 10 and 17. The Examiner cites column 8, lines 38-57 of Xue as disclosing the above-cited claim limitation. Office Action (7/9/2008), page 4. The Examiner further cites the "stop icon" of Xue as disclosing the claimed indicator. *Id.* at page 3. Applicants respectfully traverse.

Xue instead discloses that at step 305, assuming that the DSN has been successfully matched with its associated original message, then the delivery status for the recipient identified by the incoming DSN is updated in the appropriate database or data structure. Column 8, lines 38-41. Xue further discloses that at step 306, the delivery status of the original message is updated or recomputed, which can be stored in association with other information concerning the original message. Column 8, lines 42-44. Furthermore, Xue discloses that in this manner, the sender of the original message may query the current delivery status of original message. Column 8, lines 44-46. Additionally, Xue discloses that after time t_x, the sender or other user may be informed through an appropriate indication that the delivery status of the original message is final because the time period for expecting any DSNs has expired. Column 8, lines 57-60.

Hence, while Xue discloses updating the delivery status (e.g., pending to successful delivery) for the recipient identified by the incoming DSN, this does not imply clearing the failure indicator (or stop icon) in response to receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message. Once the delivery status enters the "failure" status, the stop icon or failure indicator (Examiner asserts that the stop icon or failure indicator of Xue discloses the claimed indictor) is not cleared in response to receiving an e-mail originated from the

address of the addressee corresponding to the failed delivery message. The Examiner has not pointed to any language to suggest that Xue would modify the failure status; whereas, there is language to suggest that once a status code is finalized, it cannot be changed ("that the delivery status of the original message is final" as cited in column 8, lines 57-60 of Xue).

Thus, Xue does not disclose all of the limitations of claims 3, 10 and 17, and thus Xue does not anticipate claims 3, 10 and 17. M.P.E.P. §2131.
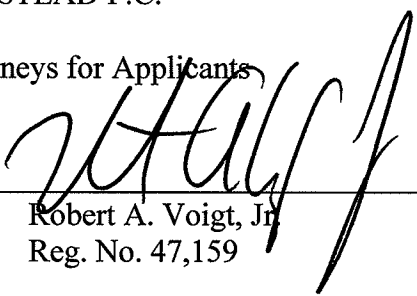
II.   <u>CONCLUSION:</u>

As a result of the foregoing, it is asserted by Applicants that claims 3, 10 and 17 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims.   Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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